

### **REMARKS**

Claims 6, 9-11, 13 and 22-75 are pending in the above-captioned patent application following this amendment. Claims 6, 9-11, 13 and 22-75 have been rejected. The applicants respectfully traverse the rejection of these claims.

No new matter is believed to have been added by this response. Consideration of the pending application is respectfully requested.

### **Rejections Under 35 U.S.C. § 102**

Claims 6, 9-11, 13 and 22-75 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shimizu et al. (USPN 6,614,627). The Applicants respectfully traverse the rejection under 35 U.S.C. §102(e) by the Patent Office on the grounds that Shimizu et al. may not be used as prior art given the ability of the Applicants to antedate this reference as more fully set forth in the declaration of inventor, Stephen P. Williams, pursuant to 37 CFR §1.131.<sup>1</sup> Because the Applicants submit that Shimizu et al. does not specifically claim the features of the rejected claims, a declaration pursuant to 37 CFR § 1.131 is believed to be proper.

37 CFR §1.131 provides when "any claim of an application ... is rejected, the inventor of the subject matter of the rejected claim, ... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. Patent, ... is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. §102(e). ... (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. ...".

As set forth more fully in the accompanying declaration of Stephen P. Williams (hereinafter "Declaration of Williams") and the attached exhibits, various species of each of the rejected independent claims were conceived of in the United States, and reduced

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<sup>1</sup> Two additional inventors, Albert Hartman and Thomas Tacklind, are no longer employees with, nor in the control of, Maxtor Corporation. Thus, no declarations of Mr. Hartman or Mr. Tacklind are provided.

to practice prior to the effective U.S. application filing date of Shimizu et al. of August 29, 2000. For example, prior to August 29, 2000, Stephen P. Williams participated in the conception and reduction to practice of: (a) A head stack assembly for a disk drive that includes an actuator arm; a coarse positioner that moves the actuator arm relative to the storage disk; a transducer assembly including a load beam, a flexure secured to the load beam, and a data transducer secured to the flexure; a separately formed base plate securing the transducer assembly to the actuator arm, the base plate including (i) one or more edges, (ii) a pair of flex sections that cantilever away from at least one of the edges, the flex sections allowing the base plate to flex, and (iii) a pair of spaced apart positioner cavities that are positioned between the flex sections; and a fine positioner secured to the base plate, the fine positioner being positioned in the positioner cavities, the fine positioner moving a portion of the base plate relative to the actuator arm; (Paragraph 3a of the Declaration of Williams);

(b) A disk drive including an actuator arm; a transducer assembly including a load beam and a data transducer coupled to the load beam; a separately formed base plate that secures the transducer assembly to the actuator arm, the base plate including a flex section that allows the base plate to flex; and a fine positioner that is secured to the base plate so that the fine positioner does not contact the flex section, the fine positioner selectively flexing at least a portion of the base plate; (Paragraph 3b of the Declaration of Williams);

(c) A disk drive including an actuator arm; a transducer assembly including a load beam and a data transducer coupled to the load beam; a separately formed base plate that secures the transducer assembly to the actuator arm; and a first piezoelectric motor having a proximal end and a distal end, that ends being secured to the base plate so that the first piezoelectric motor is under compression, the first piezoelectric motor moving a portion of the base plate relative to the actuator arm; (Paragraph 3c of the Declaration of Williams);

(d) A disk drive including an actuator arm; a transducer assembly including a load beam and a data transducer coupled to the load beam; a separately formed base plate that secures the transducer assembly to the actuator arm, the base plate including a plate mount that secures the base plate to the actuator arm; and a pair of piezoelectric

motors that are each secured to the base plate between the plate mount and the data transducer, the piezoelectric motors being substantially parallel to each other, the piezoelectric motors moving a portion of the base plate relative to the actuator arm; (Paragraph 3d of the Declaration of Williams);

(e) A disk drive including an actuator arm; a transducer assembly including a load beam and a data transducer coupled to the load beam; a separately formed base plate that secures the transducer assembly to the actuator arm, the base plate including a positioner cavity that extends through the base plate; and a fine positioner that is secured to the base plate so that the fine positioner is positioned over at least a portion of the positioner cavity, the fine positioner selectively flexing at least a portion of the base plate; (Paragraph 3e of the Declaration of Williams);

(f) A method for increasing the positioning accuracy of a disk drive including the steps of securing a transducer assembly to an actuator arm with a separately formed base plate having a flex section that flexes; securing a fine positioner to the base plate so that the fine positioner is not in contact with the flex section; and flexing the flex section with the fine positioner to cause at least a portion of the base plate to move relative to the actuator arm; (Paragraph 3f of the Declaration of Williams); and

(g) A disk drive including an actuator arm; a data transducer; a load beam that is coupled to and supports the data transducer, the load beam having a thickness; a base plate that secures the load beam to the actuator arm, the base plate having a thickness that is at least approximately three times the thickness of the load beam, the base plate including a flex section that allows the base plate to flex; and a fine positioner that is secured to the base plate so that the fine positioner does not contact the flex section, the fine positioner selectively flexing at least a portion of the base plate. (Paragraph 3g of the Declaration of Williams).

As provided more fully in the Declaration of Williams, at least prior to August 29, 2000, Mr. Williams was personally on the engineering team that conceived of in the United States various embodiments of the concepts included in the Present Application. (Declaration of Williams, ¶ 2). Further, Stephen P. Williams states that he is aware that the construction of a prototype of one or more of the embodiments of the present

invention occurred on or before August 29, 2000, as evidenced by Exhibit "A" attached to the Declaration of Williams. (Declaration of Williams, ¶ 4).

In summary, the present invention was reduced to practice by the construction of a prototype of one or more embodiments of the present invention no later than August 29, 2000, the earliest effective filing date of Shimizu et al. As set forth above, the requirements necessary to antedate Shimizu et al. have been satisfied. As a result, Shimizu et al. may not be used as prior art to reject claims 6, 9-11, 13 and 22-75, and the rejection of these claims under 35 U.S.C. §102(e) should be withdrawn.

Moreover, the Applicants respectively submit that Shimizu et al. substantively is not believed to teach or suggest the features of some or all of the rejected claims. However, in view of the ability of the Applicants to antedate of Shimizu et al. pursuant to 37 CFR 1.131, any substantive arguments regarding why Shimizu et al. does not teach the features and/or steps of the rejected claims are believed to be moot. Thus, an explanation of this rationale is believed to be unnecessary and will not be provided at this time. In the event the declaration pursuant to 37 CFR 1.131 is found for some unforeseen reason by the Patent Office not to be persuasive, the Applicants hereby reserve their rights to substantively traverse the rejected claims in view of Shimizu et al.

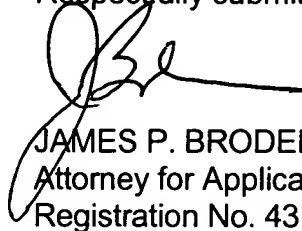
Accordingly, the Applicants respectfully submit that the rejection by the Patent Office under 35 U.S.C. § 102(e) should be withdrawn, and that claims 6, 9-11, 13 and 22-75 should be allowed. Consequently, the application is believed to be in condition for allowance.

### **CONCLUSION**

In conclusion, Applicant respectfully asserts that claims 6, 9-11, 13 and 22-75 are allowable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-672-0454 for any reason that would advance the instant application to issue.

Dated this 14<sup>th</sup> day of September, 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Broder', is written over the printed name and title.

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